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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,778	08/11/2000	David M. Goldschlag	2685/5681	1089

7590 10/02/2006
WENDY E. KOB, ESQ
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SPRINGTOWN,, PA 18081-0556

EXAMINER

VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/635,778	GOLDSCHLAG ET AL.	
	Examiner	Art Unit	
	John Van Bramer	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-27 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 20, 2006 has been entered.

Response to Amendment

2. The amendment filed on July 20, 2006 cancelled no claims. No claims were added and no claims were amended. Thus the currently pending claims remain Claims 13-27.
3. The affidavit filed on July 20, 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Challener et al. (U.S. Patent Number: 6,081,793) reference.
 - a. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Challener et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a

problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The documents supplied by the applicant to establish conception prior to February 24, 1997 describes a voting process by which a voter registers to vote and obtains a voter registration certificate. When the voter presents the certificate he is provided the ability to vote and issued a new voter registration certificate at that time for the upcoming election. However, the process disclosed by the applicant is much different. The applicants specification and claims are directed towards a process whereby the certificate issued is a vote certificate which contains information regarding the votes the voter wishes to cast. This discrepancy provides two additional concepts for which that applicant has no support of conceptions. First, the applicant needs to demonstrate the date on which the concept of incorporating voting information into a certificate supplied to a voter. Second the applicant needs to provide support for the concept of issuing new certificates at a separate time from the point of certificate usage by the voter. This is necessary because the items to be voted on for the next election will not be available when the voter uses the current certificate as discloses in the support documents.

- b. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Challener et al. reference to

either a constructive reduction to practice or an actual reduction to practice. The applicant has provided no support for diligence from a date just prior to the reduction to practice of the Challenger et al. reference up to the date on which the applicant achieve constructive reduction to practice. The applicant is reminded that simply stating that diligence was performed is not enough. An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3622

5. Claims 13-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Challener et al (6,081,793).

Claims 13, 15, 17, 21-24: Challener discloses a system, apparatus, and program for electronic voting, comprising:

- a. A processor (Item 55, Figure 2b);
- b. Instructions to cause the processor to perform the steps of:
 1. Receiving a voter registration request message (ballot request) that will bind vote authorization data (voter identification and PIN) and a blinded unvalidated vote certificate (ballot)(col 6, line 65 – col 7, line 4);
 2. Determine if the vote authorization data is valid (col 7, lines 4-16);
 3. Validating the blinded unvalidated vote certificate to obtain a blinded vote certificate if the vote authorization data is valid (col 7, lines 4-16);and
4. Sending a response message to the voter that includes the blinded validated vote certificate (certified ballot) atomically bound to the voter registration request message (col 7, lines 4-16); and
- c. Memory coupled to the processor (col 3, lines 30-35).

The Examiner notes that Challener discloses that the user receives a smart card when registering to vote. The smart card contains the voter identification, public encryption key, a ballot box ID, and a PIN number for the voter (i.e. vote authorization data). On election day, the voter places his smart card in a smart card

Art Unit: 3622

reader of the authentication server at the polling station and enters his PIN number to validate his identity which generates a "ballot request". The Examiner considers the entering of the smart card information and the PIN number and the resultant ballot request to be the equivalent of the claimed voter registration request message.

The authentication server uses the PIN number to determine if the smart card information (vote authorization data) is valid. If the vote authorization data is valid, the polling station selects a ballot ID, encrypts it along with the voter authorization data and "sends the encrypted ballot, and the ballot ID, to the voter's personal computer" (col 8, lines 1-9). The voter then decrypts the ballot with the smart card encryption key, enters his selections onto the ballot, re-encrypts the ballot using the smart card encryption key, and returns the encrypted ballot to the voting system.

The system uses at least two servers, each able to decrypt only a portion of the encrypted ballot to maintain the anonymity of the voter, while also allowing for the verification of the vote, if necessary. Thus, Challenger uses blinded encryption methods. The Examiner considers the initial ballot selected by the polling station to be the equivalent of the claimed blinded unvalidated voter certificate; the encrypted ballot sent to the voter's personal computer as the blinded validated voter certificate.

Claims 14, 16, and 18: Challenger discloses an apparatus for electronic voting as in Claims 13, 15, and 17 above, and further inherently discloses the certificate indicating a yes or no vote (col 1, lines 11-15). The Examiner notes that ballots contain one or more questions to which the voter may make one or more selections

based on his desires. Each of these selections is a vote for or against the topic of the question – whether it is a “for” (yes) or “against” (no) vote on a local tax levy proposition, “for” (yes) or “against” (no) the Presidential candidates, or “for” (yes) or “against” (no) several candidates running for several open councilmen positions. In each case, the completed ballot indicates the voter’s yes or no votes.

Claim 19: Challenger discloses an apparatus for electronic voting, comprising:

- a. A processor (Item 55, Figure 2b);
- b. Instructions to cause the processor to perform the steps of:
 1. Receiving a voter registration request message (ballot request) that will bind vote authorization data (voter identification and PIN) and a blinded unvalidated vote certificate (ballot)(col 6, line 65 – col 7, line 4);
 2. Determine if the vote authorization data is valid (col 7, lines 4-16);
 3. Validating the blinded unvalidated vote certificate to obtain a blinded vote certificate if the vote authorization data is valid (col 7, lines 4-16); and
 4. Sending a response message to the voter that includes the blinded validated vote certificate (certified ballot) atomically bound to the voter registration request message (col 7, lines 4-16); and
- c. Memory coupled to the processor (col 3, lines 30-35).

The Examiner notes that Challenger discloses that the user receives a smart card when registering to vote. The smart card contains the voter identification, public encryption key, a ballot box ID, and a PIN number for the voter (i.e. vote

authorization data). On election day, the voter places his smart card in a smart card reader of the authentication server at the polling station and enters his PIN number to validate his identity which generates a "ballot request". The Examiner considers the entering of the smart card information and the PIN number and the resultant ballot request to be the equivalent of the claimed voter registration request message. The authentication server uses the PIN number to determine if the smart card information (vote authorization data) is valid. If the vote authorization data is valid, the polling station selects a ballot ID, encrypts it along with the voter authorization data and "sends the encrypted ballot, and the ballot ID, to the voter's personal computer" (col 8, lines 1-9). The voter then decrypts the ballot with the smart card encryption key, enters his selections onto the ballot, re-encrypts the ballot using the smart card encryption key, and returns the encrypted ballot to the voting system. The system uses at least two servers, each able to decrypt only a portion of the encrypted ballot to maintain the anonymity of the voter, while also allowing for the verification of the vote, if necessary. Thus, Challenger uses blinded encryption methods. The Examiner considers the initial ballot selected by the polling station to be the equivalent of the claimed blinded unvalidated voter certificate; the encrypted ballot sent to the voter's personal computer as the blinded validated voter certificate.

Challenger also discloses methods to tabulate, correct, or challenge the votes through the use of a journal server which keeps track of each vote as it is being entered. To correct a vote, the voter again enters his PIN number and smart card data (which includes the validated ballot)(i.e. "receives a second voting

transaction message)", the system revalidates the voter (ballot)(i.e. "determines if the second voting transaction message has the same nonce, session key, and blinding factor" as the previous stored ballot); and retrieves the previously stored ballot if the second request message is valid (col 10, line 51 – col 11, line 37).

Claim 20: Challener discloses an apparatus for electronic voting as in Claim 19 above, and further inherently discloses the certificate indicating a yes or no vote (col 1, lines 11-15). The Examiner notes that ballots contain one or more questions to which the voter may make one or more selections based on his desires. Each of these selections is a vote for or against the topic of the question – whether it is a "for" (yes) or "against" (no) vote on a local tax levy proposition, "for" (yes) or "against" (no) the Presidential candidates, or "for" (yes) or "against" (no) several candidates running for several open councilmen positions. In each case, the completed ballot indicates the voter's yes or no votes.

Claims 25-27: Challener discloses a system for electronic voting as in Claim 24 above, and further discloses means for auditing, initializing, and recovering from an interruption in an electronic voting transaction (col 10, line 51 – col 11, line 37).

Response to Arguments

6. The amendment filed on July 20, 2006 contained no argument regarding the rejections contained in the Office Action dated March 31, 2006.

Conclusion

7. All claims are the same as those presented earlier in the prosecution of the application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

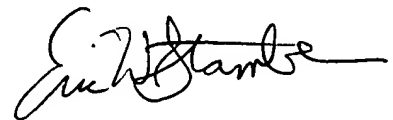
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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